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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			WASSUM, LUKE S	
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			2167	

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/997,311

Applicant(s)

SHAY ET AL.

Examiner

Luke S. Wassum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is In condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20040818.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Examiner of Record*

1. The Applicants are advised that the Examiner of Record for this application has changed.

Contact information for the new examiner can be found at the end of this Office action.

### *Appeal Brief*

2. In view of the arguments presented in the Appeal Brief filed on 1 March 2006,  
PROSECUTION IS HEREBY REOPENED. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two

ptions:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

JEFFREY CAFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2160

***Priority***

3. The Applicants' claim to domestic priority under 35 U.S.C. § 119(e) based upon U.S. Provisional Applications 60/309,244, filed 31 July 2001, and 60/253,360, filed 27 November 2000, is acknowledged.

4. Since the relevant features (specifically, the locking of the electronic documents upon receipt of the first signal from the user) appear to be supported only by the '244' application, the instant application is entitled to a priority date of 31 July 2001.

***Information Disclosure Statement***

5. The Applicants' Information Disclosure Statement, filed 18 August 2004, has been received and entered into the record. Since the Information Disclosure Statement complies with the provisions of MPEP § 609, the references cited therein have been considered by the examiner. See attached form PTO-1449.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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8. Regarding claim 15, the claim recites (as partially inherited from parent claim 12) that a package is transferred from a 'filed' phase to a 'transmitted' phase. Having given the terms 'filed' and 'transmitted' their ordinary interpretation in the art, claim 15 is rejected as indefinite, since a patent application cannot have been 'filed' with the patent office without first having been 'transmitted' to said patent office.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the

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contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-5, 9, 11-15, 19-22, 25-28 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Horikawa et al.** (European Patent Application 0,495,983 A1) in view of **Cautley et al.** (U.S. Patent Application Publication 2002/0065697).

13. Regarding claim 1, **Horikawa et al.** teaches a computer-implemented method of controlling document edits substantially as claimed, comprising:

- a) storing a plurality of alterable electronic documents on a computer system, the plurality of electronic documents being associated with a patent application (see Figure 6A, et seq., displaying the document table containing said plurality of documents associated with a patent application); and
- b) receiving from a user a first signal indicating that one or more of the electronic documents are to be filed in a patent office (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16);

**Horikawa et al.** does not explicitly teach a computer-implemented method wherein the one or more electronic documents are automatically locked.

**Cautley et al.**, however, teaches a computer-implemented method including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal from a user (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

14. Regarding claim 12, **Horikawa et al.** teaches a computer-implemented method of controlling document edits substantially as claimed, comprising:

- a) storing a plurality of alterable electronic documents on a computer system, the plurality of electronic documents being associated with a patent application (see Figure 6A, et

- seq., displaying the document table containing said plurality of documents associated with a patent application);
- b) creating a package including one or more of the electronic documents, the package being displayed in a first folder of a graphical user interface (see screenshot of the package 'Hand Scanner', containing 4 documents, Figure 18); and
- c) receiving from a user a first signal indicating that the package has been transferred from a first phase to a second phase (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16);

**Horikawa et al.** does not explicitly teach a computer-implemented method wherein the one or more electronic documents are automatically locked.

**Cautley et al.**, however, teaches a computer-implemented method including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal from a user (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would



be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

15. Regarding claim 20, **Horikawa et al.** teaches a computer-implemented method of controlling document edits substantially as claimed, comprising:

- a) storing a plurality of electronic documents on a computer system, each electronic document having a native format type (see disclosure that the system comprises a document conversion part which converts document data of various kinds of formats into the data of the document format of the terminal, Abstract, page 1; see also various native formats, elements 1, 2, 3 in drawing Figure 1);
- b) creating a package including one or more of the electronic documents (see screenshot of the package 'Hand Scanner', containing 4 documents, Figure 18); and
- c) receiving from a user a first signal indicating that a package is ready to be filed in a patent office (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16);
- d) automatically transforming the one or more electronic documents from its native format types into a type that is viewable as it will be printed (see disclosure of the merging of multiple text and image files, page 22, line 31 through page 24, line 18; see also drawing Figures 36-38); and

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e) displaying the transformed one or more electronic documents (see display 550 in drawing Figures 36 and 38; see also disclosure that screen 550 is a screen of a display device for displaying a text, an image, and so forth, page 22, line 54).

**Horikawa et al.** does not explicitly teach a computer-implemented method wherein the user is a remote user.

**Cautley et al.**, however, teaches a computer-implemented method wherein the transformed document is displayed to a remote user (see disclosure that the system can utilize a network configuration so that the proposer, reviewer and other participants can share and exchange information remotely from one another (see paragraph [0007]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to allow the final version of the documents to be displayed to remote users, since this would allow the document to be reviewed by peers without requiring said reviewers to be at the local system. Furthermore, this would also allow several reviewers to review the documents simultaneously on several different terminals.

16. Regarding claim 32, **Horikawa et al.** teaches a computer system for controlling document edits, the computer system comprising a processor and a computer readable medium substantially as claimed, comprising instructions executable by the processor to:

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- a) store a plurality of alterable electronic documents on a computer system, the plurality of electronic documents being associated with a patent application (see Figure 6A, et seq., displaying the document table containing said plurality of documents associated with a patent application); and
- b) receive from a user a first signal indicating that one or more of the electronic documents are to be filed in a patent office (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16).

**Horikawa et al.** does not explicitly teach a computer system wherein the one or more electronic documents are automatically locked.

**Cautley et al.**, however, teaches a computer system including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal from a user (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said

submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

17. Regarding claim 34, **Horikawa et al.** teaches a computer program embodied on a computer readable medium substantially as claimed, the computer program comprising instructions executable by the computer to:

- a) store a plurality of alterable electronic documents on a computer system, the plurality of electronic documents being associated with a patent application (see Figure 6A, et seq., displaying the document table containing said plurality of documents associated with a patent application); and
- b) receive from a user a first signal indicating that one or more of the electronic documents are to be filed in a patent office (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16).

**Horikawa et al.** does not explicitly teach a computer program wherein the one or more electronic documents are automatically locked.

**Cautley et al.**, however, teaches a computer program including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal from a user (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus

locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

18. Regarding claim 35, **Horikawa et al.** teaches a method of electronically filing a document in a patent office substantially as claimed, the method comprising:

- a) storing a document on a computer system, wherein the document is associated with a patent application (see Figure 6A, et seq., displaying the document table containing said plurality of documents associated with a patent application);
- b) allowing a user to edit the document (see text editing portion 8 in drawing Figure 1);
- c) receiving a signal from a user indicating that the document is ready to be filed in a patent office (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16);

- d) converting the document from a first document type into a second document type (see disclosure of the merging of multiple text and image files, page 22, line 31 through page 24, line 18; see also drawing Figures 36-38); and
- e) electronically filing the document with a patent office via an interface to an electronic filing system of the patent office (see disclosure of the transmission of the application to the patent office, page 28, lines 17-22 et seq.).

**Horikawa et al.** does not explicitly teach a method wherein the document is automatically locked in response to the signal.

**Cautley et al.**, however, teaches a method including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal from a user (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.**

reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

19. Regarding claims 2 and 37, **Horikawa et al.** additionally teaches a method further comprising storing the one or more electronic documents in a package prior to generating the first signal and filing said package electronically (see screenshot of the package 'Hand Scanner', containing 4 documents, Figure 18).

20. Regarding claim 3, **Cautley et al.** additionally teaches a method further comprising allowing a user to perform manual verification of the locked electronic documents prior to filing the documents in the patent office (see disclosure that the documents can be routed to one or more reviewers, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to allow a document to be reviewed before formally submitted, since this would allow a final verification that the contents of the document is correct (see paragraph [0005]), especially important when filing official documents such as project proposals or patent applications.

21. Regarding claims 4 and 26-28, **Horikawa et al.** additionally teaches a method further comprising electronically filing the electronic documents in the patent office including transmitting the electronic documents to the patent office via an interface to an electronic filing system of the

patent office (see disclosure of the transmission of the application to the patent office, page 28, lines 17-22 et seq.).

22. Regarding claim 5, **Cautley et al.** additionally teaches a method further comprising generating a first lock signal in response to the first signal, and in accordance therewith, automatically locking the one or more electronic documents (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

23. Regarding claim 9, **Cautley et al.** additionally teaches a method further comprising receiving a second signal indicating that the one or more of the electronic documents are final draft documents (see Document Review Decision 42 in drawing Figure 3; see also paragraph [0045]).

24. Regarding claims 11, 19 and 36, **Horikawa et al.** additionally teaches a method wherein the electronic documents include a provisional patent application specification, non-provisional patent application specification, response to an Office action, inventor declaration, assignment, power of attorney or patent drawings (see illustration of different document types, left column of the document table in drawing Figure 6A).

25. Regarding claim 13, **Cautley et al.** additionally teaches a method wherein the first phase is a final draft phase and the second phase is a ready to file phase (see disclosure of the project submission phase 34, analogous to the final draft phase, and the document review decision/version project phase 42-45-50, analogous to the ready to file phase, in drawing Figure 3).



26. Regarding claims 14 and 15, **Horikawa et al.** additionally teaches a method wherein the first phase is a final draft phase and the second phase is a filed phase, or alternately wherein the first phase is a filed phase and the second phase is a transmitted phase (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16; see also disclosure of the transmission of the application to the patent office, page 28, lines 17-22 et seq.).

27. Regarding claim 21, **Cautley et al.** additionally teaches a method further comprising locking the transformed one or more documents (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

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28. Regarding claim 22, **Horikawa et al.** additionally teaches a method further comprising generating a signal indicating that the package can be filed (see disclosure that the disk capacity must be sufficient to hold the package before the package can be transmitted, page 28, lines 48-59; see also drawing Figure 48, wherein the steps embodied in drawing elements SM5, SM6 and SM7 are analogous to the claimed signal, since these steps occur only if there is sufficient disk capacity to store the package to be transmitted).

29. Regarding claim 25, **Cautley et al.** additionally teaches a method further comprising receiving a second signal indicating that the one or more electronic documents needs to be edited, and automatically unlocking the one or more documents into an editable form (see disclosure that if the proposal is not approved, the system unfreezes the proposal to allow revision, paragraph [0007]).

30. Regarding claim 33, **Horikawa et al.** additionally teaches a computer readable medium wherein at least one of the plurality of documents is stored on a second computer system, and wherein the computer readable medium comprises further instructions executable by the processor to load the at least one of the plurality of documents from the second computer system onto the computer system prior to locking the one or more of the electronic documents (see transfer of files from second computer system via floppy disks 14, 15, 16 in drawing Figure 1).

31. Claims 6, 8, 10, 16, 18, 23, 24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Horikawa et al.** (European Patent Application 0,495,983 A1) in view of **Cautley**

**et al.** (U.S. Patent Application Publication 2002/0065697) as applied to claims 1-5, 9, 11-15, 19-22, 25-28 and 32-37 above, and further in view of **Britton** (U.S. Patent 6,591,289).

32. Regarding claims 6, 8, 10, 16 and 18, **Horikawa et al.** and **Cautley et al.** teach a computer-implemented method of controlling document edits substantially as claimed.

Neither **Horikawa et al.** nor **Cautley et al.** explicitly teaches a computer-implemented method wherein the automatic locking includes automatically converting the one or more electronic documents from a first document type to a pdf file.

**Britton**, however, teaches the conversion of files from a first document type into a pdf formatted file (see col. 2, line 53 through col. 3, line 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to convert the document to a pdf formatted file, since this allows a user to view the file in the Adobe Acrobat Reader program, without allowing the user to make changes to the file (see col. 2, line 53 through col. 3, line 9).

33. Regarding claim 23, **Horikawa et al.** and **Cautley et al.** teach a computer-implemented method of controlling document edits substantially as claimed.

Neither **Horikawa et al.** nor **Cautley et al.** explicitly teaches entering the package into an outgoing mail queue.

**Britton**, however, teaches the transmission of files over a network via email (see col. 2, lines 53-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to transmit documents via email, since email has become a common and efficient method of transferring documents electronically, thus saving the time and expense of transmitting documents in paper form (see col. 2, lines 53-59).

34. Regarding claim 24, **Horikawa et al.** additionally teaches electronically filing the package in a patent office (see disclosure of the transmission of the application to the patent office, page 28, lines 17-22 et seq.).

35. Regarding claim 31, **Horikawa et al.** additionally teaches a method further comprising electronically filing the electronic documents in the patent office including transmitting the electronic documents to the patent office via an interface to an electronic filing system of the patent office (see disclosure of the transmission of the application to the patent office, page 28, lines 17-22 et seq.).

36. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Horikawa et al.** (European Patent Application 0,495,983 A1) in view of **Cautley et al.** (U.S. Patent Application Publication 2002/0065697) as applied to claims 1-5, 9, 11-15, 19-22, 25-28 and 32-37 above, and further in view of **Haff et al.** (U.S. Patent Application 6,219,669).

37. Regarding claims 7 and 17, **Horikawa et al.** and **Cautley et al.** teach a computer-implemented method of controlling document edits substantially as claimed.

Neither **Horikawa et al.** nor **Cautley et al.** explicitly teaches a method further comprising displaying the locked image files in a file history portion of a graphical user interface providing a record of documents submitted to a patent office.

**Haff et al.**, however, teaches an event log window which displays records of all transmitted files that have been sent or received (see drawing Figure 15; see also col. 8, lines 8-16; see also col. 21, lines 46-53; see also col. 37, lines 41-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to maintain a log that tracked which documents had been transmitted from the system, since the logging of file/document transmission is important in maintaining system accountability, allowing a system administrator to determine when and if specific documents have been transmitted from the system, and where said documents were sent.

38. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Horikawa et al.** (European Patent Application 0,495,983 A1) in view of **Cautley et al.** (U.S. Patent Application Publication 2002/0065697) as applied to claims 1-5, 9, 11-15, 19-22, 25-28 and 32-37 above, and further in view of **Scott et al.** (U.S. Patent 6,489,980).

39. Regarding claims 29 and 30, **Horikawa et al.** and **Cautley et al.** teach a computer-implemented method of controlling document edits substantially as claimed.

Neither **Horikawa et al.** nor **Cautley et al.** explicitly teaches a method wherein the first signal comprises the user moving a document from a first section of a graphical user interface to a second section of a graphical user interface.

**Scott et al.**, however, teaches the uploading and downloading of files through the use of a 'drag and drop' user interface (see col. 5, lines 55-57; see also col. 6, lines 45-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a drag and drop interface to initiate the transmission of files across a network, since this type of user interface has been found to be very intuitive and simple to use, and has been in use in the user interface art for well over a decade.

### ***Conclusion***

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Petruzzi et al.** (U.S. Patent 6,049,811) teaches a machine and method for drafting a patent application.

**Britton** (U.S. Patent 6,886,025) teaches a method of delivering a formatted document over a communications network.

**Ashby** (U.S. Patent 6,970,842) teaches a project docket management apparatus.

**Lee** (U.S. Patent 7,016,851) teaches a system for the preparation of an intellectual property filing in accordance with jurisdiction- and/or agent-specific requirements.

**Porcari** (U.S. Patent Application Publication 2001/0037460) teaches a web-based document approval system.

**Hamburg et al.** (U.S. Patent Application Publication 2001/0049704) teaches a method for creating and modifying documents wherein whenever an interesting event occurs, the state of the document is automatically captured as it exists after the operation.

**Grainger et al.** (U.S. Patent Application Publication 2002/0065675) teaches a method of managing invention disclosure statements.

**Grainger et al.** (U.S. Patent Application Publication 2002/0065676) teaches a method of managing invention disclosure statements.

**Grainger et al.** (U.S. Patent Application Publication 2002/0065676) teaches a method of managing invention disclosure statements.

**Miller et al.** (U.S. Patent Application Publication 2005/0055306) teaches a collaborative system allowing members of a group to collaborate on a project such as a bid or a proposal.

**Grainger et al.** ("Specification of U.S. Provisional Patent Application 60/253,360") teaches a method of managing invention disclosure statements.

**Figura et al.** ("The Online Pathfinders") discloses the USPTO's Trademark Electronic Application System.

**USPTO** ("Frequently Asked Questions about TEAS") teaches the use of the TEAS system to electronically submit trademark applications.

**USPTO** ("USPTO to Mark 100,000<sup>th</sup> Electronic Trademark Application") is a press release.

**Grainger et al.** ("Specification of U.S. Provisional Patent Application 60/309,244") teaches a method of controlling document edits.

**Shiang** ("Software Reviews: GrantSlam 4.0.4") is a product evaluation of a grant submission software package.

**USPTO** ("e-TEAS Tutorial") teaches the use of the TEAS system for the electronic filing of trademark applications.

**MIT** ("Introduction to Coeus") documents a software package that is used to assemble and electronically submit grant applications.

**Rice University** ("Rice University's Office of Technology Transfer Launches New On-Line Application Form to Disclose New Inventions") is a press release.

**MIT** ("Coeus -- Proposal Development") is a help file detailing the feature within the Coeus system whereby when a grant proposal is submitted, "No modifications can be made to the proposal after this point."

**USPTO** ("Trademark Electronic Application System (TEAS)") teaches the background and use of the TEAS system.




Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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